

REMARKS

Claims 1-23 are pending in the present application.

Claims 1-7, 15-20, and 22 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 6,021,429 to Danknick in view of U.S. Patent No. 5,305,199 to LoBiondo et al. Claims 8-14, 21, and 23 stand rejected under 35 USC 103(a) for obviousness over LoBiondo et al. in view of Danknick.

Applicants respectfully traverse the rejections and urge allowance of the present application.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.).

Referring to claim 1, the reliance upon Danknick in support of the obviousness rejection is in error. Referring to the Abstract of Danknick, it is clear the reference is directed towards LAN systems. One of the LAN network devices determines whether another device is operating as a list manager, and if not, the network device operates as the list manager.

Claim 1 clearly recites determining a *geographical area within which the hard copy output engine is to be deployed*. Danknick is not directed towards or concerned in any fashion with determination of a geographical area within which the hard copy engine is to be deployed. By definition, the Danknick devices are proximately located in a relatively small geographical area to participate in the LAN of Danknick and the claimed determining the geographical area is not desired and is irrelevant to the disclosure of Danknick. Applicants submit a definition of Local Area Network for the Examiner's review and such clearly illustrates Danknick is not concerned with the claimed *determining the geographical area or determining the address for the supplier appropriate to the geographical area*.

Regardless, the specific teachings identified in the Office Action fail to teach or suggest the claimed determining. More specifically, the Office Action

Serial No. 09/665,349
Case No. 10003223-1
Amendment B

on page 2 identifies teachings in col. 8, line 66 - col. 9, line 30 and col. 9, line 51 - col. 10, line 8 and Figs. 1 and 5 as allegedly disclosing the claimed determining. The Examiner is mistaken.

Initially, the teachings in cols. 8 and 9 refer to one of the LAN network devices broadcasting a request to identify a list manager and operating as a slave device if a list manager already exists, or operating as the list manager which maintains a list of device addresses for LAN 1 if one does not exist. Such teachings are entirely irrelevant with respect to disclosing or suggesting determining a geographical area within which the hard copy output engine is to be deployed as claimed. Maintaining network addresses in no fair interpretation discloses the claimed determining the geographical area. The reliance upon the teachings in cols. 8-9 is misplaced and the teachings fail to disclose or suggest the claimed determining the geographical area.

The identified teachings in cols. 9-10 refer to the LAN network device operating as the list manager including storing device addresses irrespective of geographical location. The storage of the LAN network device addresses is irrelevant to the claimed determining the geographical area and the Office Action fails to draw any logical connection between operation of the LAN network device as a list manager to the claimed determining. The devices of Danknick are already operatively coupled and participating with communications of the LAN and there is no need or desire to determine the geographical location as claimed. Nonetheless, such a determination would be irrelevant to and is not disclosed nor suggested by the identification of the list manager, or operation as a list manager as disclosed in Danknick.

Applicants have electronically searched the Danknick reference and have failed to uncover any geographical teachings, or determining geographical location teachings. This absence of geographical teachings in combination with the LAN subject matter of Danknick illustrates the tenuous nature of the Examiner's interpretation of the Danknick teachings. The claimed determining the geographical area is not shown nor suggested by the prior art, and the rejection of claim 1 is improper for at least this reason.

Claim 1 recites determining the geographical area within which the engine is to be deployed. Accordingly, the geographical area is determined prior to

Serial No. 09/665,349
Case No. 10003223-1
Amendment B

deployment. The prior art references disclose devices and systems already existing in operative arrangements. There is no teaching or suggestion of the claimed determining prior to deployment of the engine as recited. The references are clearly not concerned with the prior determining. The determining prior to deployment of the engine is not shown nor suggested by the prior art and claim 1 is allowable for this additional reason.

Inasmuch as the prior art fails to disclose or suggest the determining the geographical area, the references of record are further devoid of determining the address for the supplier appropriate to the geographical area. The Office Action fails to identify any teachings which allegedly disclose the determining appropriate to the geographical area as claimed. Claim 1 is allowable for this additional reason.

Further, claim 1 clearly recites programming an electronic address into non-volatile memory. Page 3 of the Office Action relies upon teachings in cols. 7-8 as allegedly disclosing the claimed programming. The reliance is misplaced. The identified teachings disclose maintenance of a list of device addresses in DRAM 36 or storage of a device address of a current list manager in DRAM 36. By definition, the DRAM teachings relied upon fail to disclose or suggest programming into non-volatile memory as claimed. To the contrary, Danknick relies upon the storage of information in volatile memory which erases the list when the device powers down to ensure an up-to-date list of information is present as set forth in col. 7, lines 47-56. Danknick not only fails to disclose or suggest the claimed programming of the electronic address into non-volatile memory but **expressly teaches away** from the claimed subject matter. The claimed programming is not shown nor suggested in the prior art of record and claim 1 is allowable for at least this additional reason.

The Office Action fails to present a prima facie case of obviousness inasmuch as numerous claimed limitations are not shown nor suggested by the art. Furthermore, there is no motivation to support the combination of the LoBiondo teachings with the Danknick teachings.

The mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01 citing *In re Mills*, 916 F.2d

680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by a combination of references unless there is some motivation in the art to support the combination. See *ACH Hospital Systems, Inc. v. Montifiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

As discussed above, even though the reference teachings may be combined, there is no suggestion to combine the reference and the 103 rejection is improper. Danknick is concerned with management of LAN device addresses and assigning the list manager. The disparate teachings of LoBiondo are irrelevant to the purpose of list management and address management in the specific LAN arrangement. There is no motivation to combine the reference teachings and claim 1 is allowable for at least this reason.

Numerous limitations of claim 1 are not shown nor suggested by the prior art. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final Action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor

Serial No. 09/665,349
Case No. 10003223-1
Amendment B

suggested by the cited art.

Independent claim 8 recites extracting an electronic address for a vendor of the consumable from a non-volatile memory. The Office Action on page 5 recognizes LoBiondo fails to disclose or suggest the extracting an electronic address. On page 6 of the Action, it is stated Danknick disclosed extracting an electronic address referring to col. 7, lines 45-56. However, as clearly recited in Danknick, such teachings clearly refer to volatile DRAM memory and expressly teach away from non-volatile configurations. Accordingly, Danknick fails to cure the deficiencies of LoBiondo, limitations of claim 8 are not shown nor suggested by the prior art, and the 103 rejection is improper for at least this reason.

Further, the Office Action on page 6 states it would have been obvious to modify the method of LoBiondo to include the electronic address as taught by Danknick in order to control a network device on a LAN so as to operate as a list manager maintaining a list of device addresses for the LAN of Danknick. Applicants disagree.

There is no motivation to combine the reference teachings and the 103 rejection is improper for at least this reason. LoBiondo discloses usage of a reordering system. LoBiondo is not concerned with LAN teachings or LAN communications. It follows LoBiondo is not concerned with controlling a network device on a LAN to operate as a list manager maintaining a list of device addresses as alleged. To the contrary, LoBiondo discloses a consumable monitoring/ordering system. LoBiondo already discloses usage of a modem to implement the communications and in no fair interpretation may LoBiondo be considered to be concerned with operating as a list manager which maintains a list of device addresses as alleged. LoBiondo teaches a consumable monitoring/ordering system not a LAN management service. LoBiondo would not be concerned with a LAN configuration to implement reordering of supplies.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be

through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the alleged motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings. The 103 rejection of claim 8 is improper without the proper motivation and Applicant respectfully requests allowance of claim 8 in the next action.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 12, it is clear from the express teachings of LoBiondo that the reorder point calculation is performed in determining means 34 forming a portion of the *processing portion* of microprocessor 30. Such teachings fail to disclose or suggest the determining comprises determining using processing circuitry *in response to a sensor sensing that an amount of the consumable is less than the threshold amount* as set forth in claim 12. Claim 12 recites

Serial No. 09/665,349
Case No. 10003223-1
Amendment B

limitations not shown nor suggested in the art and claim 12 is allowable for at least this reason.

Referring to claim 15, *non-volatile memory includes an electronic address for a supplier of consumables for the hard copy engine.* Page 4 of the Office Action relies upon teachings in cols. 7-8 of Danknick as allegedly disclosing the claimed non-volatile memory. In fact, such teachings clearly disclose volatile DRAM memory. Further, Danknick expressly teaches away from usage of non-volatile memory as set forth in col. 7, lines 45-56. Limitations of claim 15 are not shown nor suggested and claim 15 is allowable for at least this reason.

Further, there is no motivation to support the 103 rejection and the rejection is improper for this additional reason.

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 16 recites the processor configured to extract the URL for a supplier *appropriate to a geographical area within which the hard copy output engine is deployed.* The prior art references taken alone or in combination fail to provide or suggest any teachings relative to geographical area concerns. Danknick is concerned with management of addresses irrespective and/or irrelevant to geographical areas. LoBiondo fails to disclose or suggest any teachings with respect to a geographic area. LoBiondo merely discloses a supply reordering location 40 with no teaching or suggestion of the location 40 corresponding to a geographic location of the device 10. Limitations of claim 16 are not shown nor suggested and claim 16 is allowable for at least this additional reason.

Referring to claim 23, the prior art references, taken alone or in combination, fail to disclose or suggest *determining a geographical area within which a hard copy output engine is to be deployed* or determining the electronic address for a *consumable supplier appropriate to the geographical area.* The prior art is directed towards already existing arrangements and fails to disclose or suggest the claimed determining any geographical area *before deployment* or determining the *address of the supplier appropriate to the determined*

geographical area. The prior art further fails to disclose or suggest storing the electronic address in non-volatile memory. Limitations of claim 23 are not shown nor suggested, and claim 23 is allowable for at least this reason.

Further, there is no motivation to support the 103 rejection and the rejection is improper for this additional reason.

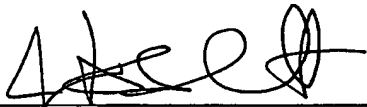
The Office Action fails to identify teachings of the art which allegedly disclose or suggest numerous limitations of Applicants' claims, and at least some of the deficiencies are identified above. Applicants respectfully request issuance of a Non-Final Action to cure the deficiencies of the present Action in accordance with CFR 1.104(c)(2) if any of the claims are not allowed.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
Mark A. Harper
Robert E. Haines

By:


James D. Shaurette

Reg. No. 39,833

Date: 9/5/03

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☒ **OTHER:** Copies

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.